

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 23, 2004. Applicant appreciates the Examiner's consideration of the Application. Claims 2 and 16 have been canceled, and Claims 1, 9, 15, 23, 29, and 31 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. Applicant makes no admission that these amendments narrow the scope of the claims or that the amendments are required for patentability. Applicant respectfully submits that no new matter has been added by the amendments to the claims. In order to advance prosecution of this Application, Applicant has responded to each notation by the Examiner. Applicant respectfully requests reconsideration and favorable action in this case.

Section 101 Rejection

Applicant has made clarifying amendments to Claims 1 and 29 to recite "displaying a contract template on a website," and "receiving a contract generated from the contract template displayed on the website." Claims 1 and 29, particularly as amended, sufficiently apply, involve, use, or advance the technical arts, and are thus Claims 1 and 29, along with their respective dependent claims, are allowable under 35 U.S.C. § 101.

Section 103(a) Rejection

The Examiner rejects Claims 1, 2, 4-16, and 18-37 under 35 U.S.C. § 103(a) as being unpatentable over "Managing by Projects" by LeRouge ("*LeRouge*") in light of "A Stakeholder Approach to Strategic Performance Measurement" by Atkinson et al. ("*Atkinson*"), and rejects Claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *LeRouge* and *Atkinson* and further in view of "Digital Signatures: Signing and Notarizing Electronic Forms" by Theofanos et al. ("*Theofanos*"). Applicant respectfully traverses this rejection for the reasons discussed below.

Applicant respectfully submits that the combination of *LeRouge* and *Atkinson* as suggested by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicant's claims. For example, the *LeRouge-Atkinson* combination suggested by the Examiner fails to disclose, teach, or suggest the following element recited in independent Claim 1, as amended:

a contract generated from the contract template displayed on the website, the contract specifying an agreement between an organization and a project owner employed by the organization, the agreement made by the project owner to take responsibility for implementing a project according to a schedule.

First, *LeRouge* fails to disclose, teach, or suggest the contract of Claim 1. *LeRouge* discloses software tools that allow project managers to manage projects. According to *LeRouge*, a project manager is an individual who is in charge of a project and who has direct authority to run a project. (*LeRouge*, page 73, column 2; page 71, column 2.) *LeRouge*, however, fails to disclose, teach, or suggest that the project managers enter into a contract to take responsibility for implementing a project according to a schedule.

The tools disclosed by *LeRouge* may provide “contract management capabilities such as document control, change-order updates, and contact records.” (*LeRouge*, page 73, column 3.) Examples of contracts disclosed by *LeRouge* include sales contracts and government contracts. (*LeRouge*, page 79, column 4.) *LeRouge*, however, fails to disclose, teach, or suggest a contract specifying an agreement made by a project owner to take responsibility for implementing a project according to a schedule. Accordingly, *LeRouge* fails to disclose, teach, or suggest “a contract generated from the contract template displayed on the website, the contract specifying an agreement between an organization and a project owner employed by the organization, the agreement made by the project owner to take responsibility for implementing a project according to a schedule,” recited in independent Claim 1, as amended.

Second, *Atkinson* fails to disclose, teach, or suggest the contract of Claim 1. *Atkinson* describes contracts between companies and shareholder groups. (*Atkinson*, page 27, column 2.) *Atkinson*, however, makes no mention of a contract specifying an agreement made by the project owner to take responsibility for implementing a project according to a schedule, much less such a contract generated from a contract template displayed in a website. Moreover, *Atkinson* teaches away from such use of explicit contracts:

Formerly, they [organizations] relied on short-term, market-based contracts that use audits to verify compliance with specified, measurable contract parameters, such as quantity, quality, and delivery time. Now they establish longer term, implicit contracts that rely on trust, motivation, and a learning relationship to deliver intangibles such as service, flexibility, and innovation. ... Not only do implicit contracts offer the potential for developing high-quality, lower cost products, but when the conditions are right for implicit contracting (that is, there is a basis for trust), implicit contracts can eliminate

or at least reduce the significant transaction costs relating to finding partners, writing contracts, and monitoring compliance.

(*Atkinson*, page 29, columns 1-2.) Accordingly, *Atkinson* fails to disclose, teach, or suggest “a contract generated from the contract template displayed on the website, the contract specifying an agreement between an organization and a project owner employed by the organization, the agreement made by the project owner to take responsibility for implementing a project according to a schedule,” recited in independent Claim 1, as amended.

Third, *LeRouge* and *Atkinson* teach away the *LeRouge-Atkinson* combination suggested by the Examiner. It is improper to combine references where the references teach away from their combination. M.P.E.P. §2145 (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). As discussed above, *LeRouge* discloses project software tools that provide contract management capabilities. (*LeRouge*, page 73, column 3.) Also as discussed above, *Atkinson* advocates the use of implicit contracts instead of explicit contracts because implicit contracts reduce costs related to writing contracts and monitoring compliance. Implicit contracts, however, cannot be managed by a software tool. Accordingly, *LeRouge* and *Atkinson* teach away the *LeRouge-Atkinson* combination suggested by the Examiner.

Consequently, at a minimum, *LeRouge* and *Atkinson*, whether separately or in combination with each other, with *Theofanos*, or with assumptions or Official Notices as suggested by the Examiner, fail to disclose the elements specifically recited in independent Claim 1.

Applicant's dependent claims are allowable based on their dependence on the independent claim and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicant believes he has amply demonstrated the allowability of the independent claims over the references of the rejection, and to avoid burdening the record, Applicant has not provided detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so. Applicant also respectfully requests reconsideration and allowance of independent Claim 1, together with its dependent claims.

Independent Claims 15 and 29 recite certain limitations substantially similar to those recited in independent Claim 1. Accordingly, for at least the same reasons, Applicant also

respectfully requests reconsideration and allowance of independent Claims 15 and 29, together with their dependent claims.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6494.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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